

REMARKS

Claims 1-39 are currently pending in this application. Based on the remarks made herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

By this amendment, Applicant has amended the claims to more appropriately recite the present invention. It is respectfully submitted that these amendments are being made without conceding the propriety of the Examiner's rejection, but merely to timely advance prosecution of the present application.

In the outstanding Official Action, the Examiner rejected claims 1-39 under 35 U.S.C. §103(a) as being unpatentable over Flickinger (USP 5,629,499) in view of Sekendur (USP 5,477,012). Applicant respectfully traverses these rejections.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1-39 are not rendered unpatentable by the combination of Flickinger and Sekendur for at least the reason that the combination fails to disclose each and every claimed element.

More specifically, Applicant maintains that neither Sekendur nor Flickinger, independently or in combination, teach or suggest, at least, "a position-coding pattern located on the surface and detectable by an optical sensor, wherein each position is encoded by directions of displacements between a plurality of marks and raster points, wherein one raster point contributes to the coding of a plurality of positions;" as recited in claim 1.

As correctly noted by the Examiner, Flickinger fails to disclose an optically detectable position coding pattern of any kind. Accordingly, the Examiner relies on the teachings of Sekendur to overcome the deficiencies of Flickinger. More specifically, the Examiner asserts that Sekendur discloses a position coding pattern wherein each position is encoded by directions

of displacements between a plurality of marks and raster points inasmuch as Sekendur discloses a position coding pattern.

Although Sekendur discloses a position coding pattern, nowhere in Sekendur is there any disclosure or suggestion that each position is encoded by directions of displacements between a plurality of marks and raster points, wherein one raster point contributes to the coding of a plurality of positions.

The Examiner rejects the claims asserting

The “raster” is taught in Sekendur as the “center circle 4,” which is consistent with the definition of a visible or virtual reference point of the displaced “marks.” See, Sekendur, figure 1, and col.4, lines 30-32. The “marks” are taught in Sekendur as the “slices 7” which are oriented around the “center circle 4” and which, by their displaced position relative to the “center circle 4” indicate the location of the indicator on the page. See Sekendur, figure 1, and col. 4, lines 28-41.)

Sekendur discloses in col. 4, lines 28-41 as follows:

One embodiment comprises a surface systematically coded with a plurality of dots 1 in FIG. 1 designating coordinates. Each dot 2 in FIG. 1 is divided into three concentric circles partitioned into quadrants 3 in FIG. 1. The center circle 4 in FIG. 1 forms a small dot, while the other circles form the inner 5 in FIG. 1 and outer 6 in FIG. 1 rings. Each quadrant of each ring represents a digit of a four digit number and is further divided into four equal slices 7 in FIG. 1. The upper right quadrant is the first digit moving clockwise. The outer ring represents the X coordinate and the inner ring represents the Y coordinate. A combination of dark and light slices in the rings of each dot indicates an X-Y coordinate FIG. 2. The use of the center dot for additional data is optional.

However, nowhere in Sekendur is there any teaching or suggestion directed to each position being encoded by directions of displacements between a plurality of marks and raster points, **wherein one raster point contributes to the coding of a plurality of positions.**

Since Flickinger and Sekendur both fail to disclose or suggestion a position-coding pattern wherein each position is encoded by directions of displacements between a plurality of marks and raster points as claimed, **wherein one raster point contributes to the coding of a plurality of positions**, the combination of these two references cannot possibly disclose or

suggest said elements. Therefore, even if one skilled in the art were motivated to combine Flickinger and Sekendur, which Applicant does not concede, the combination would still fail to render claim 1 unpatentable because the combination fails to disclose each and every claimed element.

As such, Applicant respectfully submits that claim 1 is patentable over the references as cited.

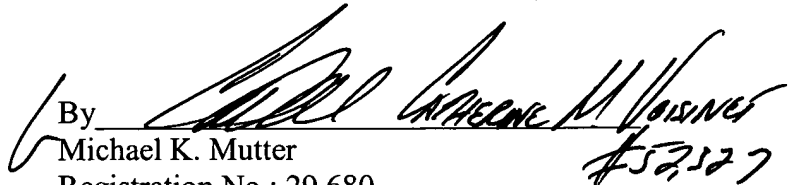
It is respectfully submitted that claims 2-8 and 28-32 are allowable for the reasons set forth above with regard to claim 1 at least based on their dependency on claim 1. It is further respectfully submitted that claims 9, 11-13, 15-16, 22-23 include elements similar to those discussed above with regard to claim 1 and thus these claims, together with claims dependent thereon are allowable for the reasons set forth above with regard to claim 1.

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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